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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,889	03/26/2004	Yoshifumi Tanimoto	042089	7798

38834 7590 11/30/2006

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EXAMINER

SAMS, MATTHEW C

ART UNIT PAPER NUMBER

2617

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/809,889	Applicant(s) TANIMOTO, YOSHIFUMI	
	Examiner Matthew C. Sams	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action has been changed in response to the amendment filed on 10/16/2006.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorenbosch et al. (US 2002/0173308 hereinafter, Dorenbosch) in view of Ogle et al. (US-6,430,604 hereinafter, Ogle).

Regarding claim 1, Dorenbosch teaches a communication device (Fig. 1 [12]) with a means for logging into a server that offers instant message service (Fig. 1 [16]), means for receiving an instant message having a forwarding destination (Page 2 [0020]), means for storing the instant message (Page 2 [0020]), means for detecting whether or not a user designated as the forwarding destination is logged in the server (Page 1 [0018]), and means for transmitting to the forwarding destination, the instant message stored in the means for storing when the user logs into the server. (Page 2 [0020]) Dorenbosch differs from the claimed invention by not explicitly reciting that the

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instant message is received regardless of whether the user designated as the forwarding destination has logged into the server.

In an analogous art, Ogle teaches a technique for enabling messaging systems to use alternative delivery mechanisms that includes accepting instant messages and storing them in a queue even though the user is not currently logged on to the instant messaging system. (Abstract & Col. 2 lines 47-52) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the instant messaging system of Dorenbosch after modifying it to incorporate the message storage and delivery of Ogle. One of ordinary skill in the art would have been motivated to do this since with an instant messaging system, a user is aware of the status of the recipient and has the option to have a message delivered to the recipient when the recipient connects to the instant messaging server or can try to reach the potential recipient through another manner. (Col. 1 line 50 through Col. 2 line 41)

Regarding claim 2, Dorenbosch in view of Ogle teaches a means for adding to an instant message to be transmitted to the user, information of a transmitter included in the instant message received by the means for receiving. (Dorenbosch Fig. 3, Page 2 [0021] and Page 3 [0032])

Regarding claim 3, Dorenbosch in view of Ogle teaches a means for transmitting to the transmitter, when a prescribed period of time elapses after the means for receiving receives the instant message, an instant message indicating such a fact. (Dorenbosch Fig. 4 [56 & 58] and Page 2 [0023])

Regarding claim 4, Dorenbosch in view of Ogle teaches a means for detecting whether or not the user is logged in server. (Dorenbosch Page 2 [0023])

Regarding claim 5, Dorenbosch in view of Ogle teaches the means for receiving receives a first instant message including a transmission destination, a transmitter, a forwarding destination and a main text. (Dorenbosch Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 6, Dorenbosch in view of Ogle teaches a means for generating a second instant message including a transmission destination, a transmitter, a forwarder and main text in accordance with the first instant message. (Dorenbosch Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

Regarding claim 7, Dorenbosch teaches a communication device (Fig. 1 [12]) with a means for logging into a server that offers instant message service (Fig. 1 [16]), means for receiving from a client terminal of a forwarder, an instant message including identification information of a client terminal of a forwarding destination (Page 2 [0020] and Fig. 1 [10]), means for storing the instant message (Page 2 [0020]), means for detecting whether or not a user designated as the forwarding destination is under active status (Page 1 [0018]), and means for transmitting the instant message stored in the storing means when the client terminal is under active status. (Page 2 [0020] and Fig. 7) Dorenbosch differs from the claimed invention by not explicitly reciting that the instant message is received regardless of whether the client terminal designated as the forwarding destination has logged into the server.

In an analogous art, Ogle teaches a technique for enabling messaging systems to use alternative delivery mechanisms that includes accepting instant messages and storing them in a queue even though the client terminal of the forwarding destination is not currently logged on to the instant messaging system. (Abstract & Col. 2 lines 47-52) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the instant messaging system of Dorenbosch after modifying it to incorporate the message storage and delivery of Ogle. One of ordinary skill in the art would have been motivated to do this since with an instant messaging system, a user is aware of the status of the recipient and has the option to have a message delivered to the recipient when the recipient connects to the instant messaging server or can try to reach the potential recipient through another manner. (Col. 1 line 50 through Col. 2 line 41)

Regarding claim 8, the limitations of claim 8 are rejected as being the same reason set forth above in claim 2.

Regarding claim 9, Dorenbosch in view of Ogle teaches a means for transmitting to the client terminal of the forwarder, when a prescribed period of time elapses after the means for receiving receives the instant message and the instant message fails to be transmitted to the client terminal of the forwarding destination an instant message indicating such a fact. (Dorenbosch Fig. 6 [86])

Regarding claim 10, Dorenbosch in view of Ogle teaches the means for detecting whether or not the client terminal of the forwarding destination is under the active status by inquiring the server. (Dorenbosch Page 1 [0002 & 0004] and Page 2 [0020])

Regarding claim 11, Dorenbosch in view of Ogle teaches the means for receiving from the client terminal of forwarder, a first instant message including identification information of the communication device as transmission destination information, identification information of the client terminal of the forwarder as transmitter information, identification information of the client terminal of the forwarding destination as forwarding destination information and main text. (Dorenbosch Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 12, Dorenbosch in view of Ogle teaches a means for generating a second instant message including the identification information of the client terminal of the forwarding destination as transmission destination information, the identification information of the communication device as transmitter information, the identification information of the client terminal of the forwarder as forwarder information, and main text in accordance with the first instant message, wherein the client terminal of the forwarding destination is under the active status, the means for transmitting transmits the second instant message to the client terminal of the forwarding destination. (Dorenbosch Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

Regarding claim 13, Dorenbosch teaches a communication method comprising detecting by a terminal of a forwarder, whether or not a user of a terminal of a forwarding destination is logged in an instant message server (Page 2 [0023]), storing the instant message received from the terminal of the forwarder in means for storing of the communication device (Page 2 [0020]), detecting by the communication device, whether or not the user of the forwarding destination designated as the terminal of the

forwarding destination is logged in the instant message server (Page 2 [0023]) and transmitting the instant message stored in the means for storing from the communication device to the terminal of the forwarding destination when the user of the forwarding destination logs into the instant message server. (Page 2 [0020-0024]) Dorenbosch teaches transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device (Page 2 [0020] and Fig. 6 [86]), but differs from the claimed invention by not explicitly reciting when the user of the forwarding destination is not logged in the instant message server.

In an analogous art, Ogle teaches a technique for enabling messaging systems to use alternative delivery mechanisms that includes accepting instant messages and storing them in a queue even though the use of the forwarding destination is not currently logged on to the instant messaging system. (Abstract & Col. 2 lines 47-52) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the instant messaging system of Dorenbosch after modifying it to incorporate the message storage and delivery of Ogle. One of ordinary skill in the art would have been motivated to do this since with an instant messaging system, a user is aware of the status of the recipient and has the option to have a message delivered to the recipient when the recipient connects to the instant messaging server or can try to reach the potential recipient through another manner. (Col. 1 line 50 through Col. 2 line 41)



Regarding claim 14, Dorenbosch in view of Ogle teaches adding an instant message to be transmitted from the communication device to the terminal of the forwarding destination, transmitter information included in the instant message which the communication device received from the terminal of the forwarder. (Dorenbosch Fig. 3, Page 2 [0021] and Page 3 [0032])

Regarding claim 15, Dorenbosch in view of Ogle teaches the step of transmitting, when a prescribed period of time elapses after the communication device receives the instant message from the terminal of the forwarder, an instant message indicating such a fact from the communication device to the terminal of the forwarder. (Dorenbosch Fig. 4 [56 & 58] and Page 2 [0023])

Regarding claim 16, Dorenbosch in view of Ogle teaches the step of transmitting the instant message from the terminal of the forwarder to the terminal of the forwarding destination without intervening the communication device when the user of the forwarding destination is logged in the instant message server. (Dorenbosch Page 2 [0020] through Page 3 [0027])

Regarding claim 17, the limitations of claim 17 are rejected as being the same reason set forth above in claim 4.

Regarding claim 18, Dorenbosch in view of Ogle teaches receiving a first instant message including a transmission destination, a transmitter, a forwarding destination and main text from the terminal of the forwarder. (Dorenbosch Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 19, Dorenbosch in view of Ogle teaches a means for generating a second instant message including a transmission destination, a transmitter, a forwarder and main text as an instant message to be transmitted to the terminal of the forwarding destination in accordance with the first instant message. (Dorenbosch Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 7 and 13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS

11/1/2006



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